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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,216

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Ryouichi Ochi

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DICKSTEIN SHAPIRO LLP

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EXAMINER

SAFAIPOUR, BOBBAK

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/724,216

Applicant(s)

OCHI ET AL.

Examiner

Bobbak Safaipoor

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/16/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Action is in response to Applicant's response filed on 4/17/2007. **Claims 1-8** are still pending in the present application. **This action is made FINAL.**

#### ***Response to Arguments***

Applicant's arguments with respect to independent claims 1, 2, 7, and 8 have been fully considered but they are not persuasive.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

In the present application, Applicant essentially argues that Tsukamoto (US 2002/0065108) fails to teach "extracting prescribed hardware information from hardware information of said portable information processing terminal by an information processor of said portable information processing terminal." Applicant argues that the none of the information stored in the memory section such as the control program of the control section, ID data of one's own machine necessary for authentication, various kinds of control data, and various kinds of set data is prescribed hardware information. Furthermore, a telephone book storage area, call origination history storage area, call reception history storage area, mail transmission history storage area, and mail arrival history storage area is not prescribed hardware information. None of the data located in the memory section of Tsukamoto, including a communication party's

Art Unit: 2618

name, their telephone number, the call origination flag or call reception flag, their electronic mail address, or a mail transmission flag or mail arrival flag, teaches or suggests "prescribed hardware information from hardware information of said portable processing terminal."

Examiner respectfully disagrees. Due to the broadness of the claim language, the recited claim language is given the broadest reasonable interpretation. There are many examples disclosed in the Tsukamoto reference that teaches "prescribed hardware information from hardware information of said portable processing terminal."

It is not clear from the specification what the explicit definition of what hardware information is and, more importantly, how one would distinguish hardware information from any other type of information received by the processor.

Tsukamoto discloses a TDMA decoder that separates a speech signal and a mail signal from the communication sub-signal (read as prescribed hardware information), wherein the speech signal is supplied to the communication section and the mail signal is supplied to the controller (paragraph 42). One of ordinary skill in the art may define the term "hardware information" as information concerning the actual physical computing machinery. Therefore, when the TDMA decoder separates speech and mail signals, this can be interpreted as prescribed hardware information.

Tsukamoto also discloses a memory section that comprises a telephone book storage area, call origination history storage area, call reception history storage area, mail transmission history storage area, and mail arrival history storage area (paragraph 48). The control section uses a microcomputer for controlling the various sections related to the TDMA communication and electronic mail transmission/reception, counting the time, controlling the edition of

Art Unit: 2618

telephone book stored in the memory section upon demanding by the user through the key input, and controlling of creation of a transmit electronic mail and display of an arrival electronic mail (paragraph 56). When a user presses his keypad on his communication device to look for a person to call, depending on the call origination history flag ("0" or "1"), the user will need to either look at the name and/or telephone number of a particular person. If the party's name is not registered in the telephone book, the name field is blank, so that the origination history flag is set to "0." Therefore, whether or not the flag is set to "0" or "1" depends if the party's name is registered in the telephone book, i.e. "prescribed hardware information." In other words, one of ordinary skill in the art may interpret whether or not a name is registered as "prescribed hardware information," information that concerns the actual physical computing machinery. Tsukamoto further discloses that if the party's name is not registered in the telephone book, the name field is blank, so the call reception history flag, mail transmission flag, and/or arrival history flag is set to "0" (paragraphs 49-58).

Additionally, Tsukamoto discloses the processes carried out when a call is originated from the communication device, when a mail is transmitted from the communication device, when a call is received at the communication device, and when a mail is arrived at the communication device (figures 7-10). In each of these processes, it is determined whether or not if the destination's telephone number or mail address is stored in the telephone book. As explained above, this depends on the "hardware information." If it is stored, then the device is applied to record the corresponding name in the origination or arrival history. If it is not stored, then only the phone or email address is shown (figures 7-10; paragraphs 61-91).

As a result, the argued features are written such that they read upon the cited references; therefore, the previous rejection still applies.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-2 and 4-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tsukamoto (US Patent Application Publication #2002/0065108 A1)** in view of **Vertaschitsch et al (US Patent #6,976,217 B1)**.

Consider **claim 1**, Tsukamoto discloses a telephone control method for a portable information processing terminal, which comprises extracting prescribed hardware information (figures 1 and 7, paragraph 49; The telephone book storage area is used to store a telephone book including a communication party's name associated with his or her telephone number) from hardware information of said portable information processing terminal by an information processor (figure 1, paragraphs 56-58; Control Section) of said portable information processing terminal. (Figures 1 and 7, paragraphs 49-58; The control section uses a microcomputer as its main control, having functions for controlling the edition of telephone book stored in the memory section. The control section also has function for call origination/reception and creating a call origination/reception history in which a communication party's name and telephone number are associated with the origination/reception time.)

Tsukamoto fails to disclose performing telephone operation control on the basis of the hardware information thus extracted.

In related art, Vertaschitsch et al disclose a PDA that comprises a mobile radio device that provides connectivity to a cellular telephone network. A system bus carries data and commands to/from the processing unit from/to other devices with the PDA. In addition to the operating system and user-selected applications, another application, a phone device, executes on the processing unit. The PDA has interactive hardware and software functions to be configured

Art Unit: 2618

for use with the cellular telephone capabilities of the PDA. Furthermore, Vertaschitsch et al disclose in figure 3 a PDA device that includes a mobile radio device and a phone control processor. The mobile radio device receives instructions and other control data from the phone control processor implementing those instructions and using the data so as to operate the mobile radio device. (Figures 2-3, col. 3, line 45 to col. 4, line 20, col. 5 lines 1-48)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Vertaschitsch et al into the teachings of Tsukamoto to improve the performance, convenience, and usability of PDA having mobile telephone capabilities.

Consider **claim 2**, Tsukamoto discloses a telephone control method for a portable information processing terminal, which comprises extracting prescribed hardware information (figures 1 and 7, paragraph 49; The telephone book storage area is used to store a telephone book including a communication party's name associated with his or her telephone number) from hardware information of said portable information processing terminal by an information processor (figure 1, paragraphs 56-58; Control Section) of said portable information processing terminal, and controlling prescribed hardware associated with the prescribed hardware information on the basis of the hardware information thus extracted. (Figures 1 and 7, paragraphs 49-58; The control section uses a microcomputer as its main control, having functions for controlling the edition of telephone book stored in the memory section. The control section also has function for call origination/reception and creating a call origination/reception history in



which a communication party's name and telephone number are associated with the origination/reception time.) .

Tsukamoto fails to disclose controlling prescribed hardware associated with the prescribed hardware information on the basis of the telephone control information of said portable information processing terminal.

In related art, Vertaschitsch et al disclose a PDA that comprises a mobile radio device that provides connectivity to a cellular telephone network. A system bus carries data and commands to/from the processing unit from/to other devices with the PDA. In addition to the operating system and user-selected applications, another application, a phone device, executes on the processing unit. The PDA has interactive hardware and software functions to be configured for use with the cellular telephone capabilities of the PDA. Furthermore, Vertaschitsch et al disclose in figure 3 a PDA device that includes a mobile radio device and a phone control processor. The mobile radio device receives instructions and other control data from the phone control processor implementing those instructions and using the data so as to operate the mobile radio device. (Figures 2-3, col. 3, line 45 to col. 4, line 20, col. 5 lines 1-48)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Vertaschitsch et al into the teachings of Tsukamoto to improve the performance, convenience, and usability of PDA having mobile telephone capabilities.

Consider **claim 7**, Tsukamoto discloses a telephone control program product embodied on a storage portion of a portable information processing terminal and comprising code that, when said program product executed, cause said portable information processing terminal to

Art Unit: 2618

perform a telephone control method comprising: a first step of extracting prescribed hardware information (figures 1 and 7, paragraph 49; The telephone book storage area is used to store a telephone book including a communication party's name associated with his or her telephone number) from hardware information of said portable information processing terminal by an information processor (figure 1, paragraphs 56-58; Control Section) of said portable information processing terminal (Figures 1 and 7, paragraphs 49-58; The control section uses a microcomputer as its main control, having functions for controlling the edition of telephone book stored in the memory section. The control section also has function for call origination/reception and creating a call origination/reception history in which a communication party's name and telephone number are associated with the origination/reception time), and a second step of comparing the prescribed hardware information thus extracted with the recorded telephone operation processing corresponding to the hardware information of said portable information processing terminal (figure 7, paragraphs 50 and 60-66; The call origination history storage area stores a call origination history including a call origination history flag indication presence/non-presence of a call destination's telephone number in the telephone book storage area (read as comparing the prescribed hardware information thus extracted)).

Tsukamoto fails to disclose carrying out the telephone operation control corresponding to the prescribed hardware information by the information processor.

In related art, Vertaschitsch et al disclose a PDA that comprises a mobile radio device that provides connectivity to a cellular telephone network. A system bus carries data and commands to/from the processing unit from/to other devices with the PDA. In addition to the operating system and user-selected applications, another application, a phone device, executes on

Art Unit: 2618

the processing unit. The PDA has interactive hardware and software functions to be configured for use with the cellular telephone capabilities of the PDA. Furthermore, Vertaschitsch et al disclose in figure 3 a PDA device that includes a mobile radio device and a phone control processor. The mobile radio device receives instructions and other control data from the phone control processor implementing those instructions and using the data so as to operate the mobile radio device. (Figures 2-3, col. 3, line 45 to col. 4, line 20, col. 5 lines 1-48)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Vertaschitsch et al into the teachings of Tsukamoto to improve the performance, convenience, and usability of PDA having mobile telephone capabilities.

Consider **claim 8**, Tsukamoto discloses a telephone control program product embodied on a storage portion of a portable information processing terminal and comprising code that, when said program product executed, cause said portable information processing terminal to perform a telephone control method comprising: a first step of extracting prescribed hardware information (figures 1 and 7, paragraph 49; The telephone book storage area is used to store a telephone book including a communication party's name associated with his or her telephone number) from hardware information of said portable information processing terminal by an information processor (figure 1, paragraphs 56-58; Control Section) of said portable information processing terminal (Figures 1 and 7, paragraphs 49-58; The control section uses a microcomputer as its main control, having functions for controlling the edition of telephone book stored in the memory section. The control section also has function for call origination/reception

Art Unit: 2618

and creating a call origination/reception history in which a communication party's name and telephone number are associated with the origination/reception time), and a second step of comparing the hardware information thus extracted and the telephone control information of said portable information processing terminal with the recorded control information associated with the hardware corresponding to the telephone control information of said portable information processing terminal (figure 7, paragraphs 50 and 60-66; The call origination history storage area stores a call origination history including a call origination history flag indication presence/non-presence of a call destination's telephone number in the telephone book storage area (read as comparing the prescribed hardware information thus extracted)).

Tsukamoto fails to disclose carrying out the control of the hardware corresponding to the telephone control information of said portable information processing terminal.

In related art, Vertaschitsch et al disclose a PDA that comprises a mobile radio device that provides connectivity to a cellular telephone network. A system bus carries data and commands to/from the processing unit from/to other devices with the PDA. In addition to the operating system and user-selected applications, another application, a phone device, executes on the processing unit. The PDA has interactive hardware and software functions to be configured for use with the cellular telephone capabilities of the PDA. Furthermore, Vertaschitsch et al disclose in figure 3 a PDA device that includes a mobile radio device and a phone control processor. The mobile radio device receives instructions and other control data from the phone control processor implementing those instructions and using the data so as to operate the mobile radio device. (Figures 2-3, col. 3, line 45 to col. 4, line 20, col. 5 lines 1-48)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Vertaschitsch et al into the teachings of Tsukamoto to improve the performance, convenience, and usability of PDA having mobile telephone capabilities.

Consider **claim 4**, and **as applied to claim 2 above**, Tsukamoto discloses the claimed invention wherein the hardware information thus extracted is a light amount state of a display portion of said portable information processing terminal and the control of the prescribed hardware is a light amount control of the display portion. (Tsukamoto: figure 1, paragraphs 47 and 55). Tsukamoto fails to disclose the telephone control information is information indicating whether a telephone call state is possible or not.

In related art, Vertaschitsch et al disclose a phone control program has operations for configuring the mobile radio device 340 to make a call, answer an incoming call, or is pre-programmed to continue ringing or other notification until a lost call signal is received from the phone control application indicating that there is no longer an incoming call. (figures 6 and 7; col. 7, line 10 - col. 9, line 12)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Vertaschitsch et al into the teachings of Tsukamoto to improve the performance, convenience, and usability of PDA having mobile telephone capabilities.

Consider **claim 5**, and as **applied to claim 2 above**, Tsukamoto, as modified by Vertaschitsch et al, discloses the claimed invention wherein hardware information thus extracted is a list of applications being operated of said portable information processing terminal (Vertaschitsch et al: col. 5, lines 12-17; The software includes a phone user interface, operating system, and other application, such as word processors, spreadsheets, or databases), the telephone control information is a call notification (Vertaschitsch et al: figure 6; col. 7, line 55 - col. 8, line 35; The phone control program has operations for configuring the mobile radio device 340 to make a call, answer an incoming call, or is pre-programmed to continue ringing or other notification until a lost call signal is received from the phone control application indicating that there is no longer an incoming call), and the control of the prescribed hardware is a control of finishing at least one application (Vertaschitsch et al: col. 5, lines 24-28).

Consider **claim 6**, and as **applied to claim 2 above**, Tsukamoto, as modified by Vertaschitsch et al, discloses the claimed invention wherein portable information processing terminal has a voice processing device, the hardware information thus extracted indicates the state of the voice processing device (Vertaschitsch et al: col. 10, lines 20-28; Included in the software programming of the microprocessor is a software module for implementing transferring audio and voice data), the telephone control information indicates whether a telephone call state is possible or not (Vertaschitsch et al: figure 6; col. 7, line 55 - col. 8, line 35; The phone control program has operations for configuring the mobile radio device 340 to make a call, answer an incoming call, or is pre-programmed to continue ringing or other notification until a lost call signal is received from the phone control application indicating that there is no longer an

Art Unit: 2618

incoming call), and the control of the prescribed hardware is a control for transmitting voice data to the voice processing device (Vertaschitsch et al: col. 10, lines 20-28; Included in the software programming of the microprocessor is a software module for implementing transferring audio and voice data).

**Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Tsukamoto (US Patent Application Publication #2002/0065108 A1)** in view of **Vertaschitsch et al (US Patent #6,976,217 B1)** and in further view of **Jones, Jr. (US Patent #5,974,334)**.

Consider **claim 3**, and as applied to **claim 1** above, Tsukamoto, as modified by Vertaschitsch et al, discloses the claimed invention except for wherein the hardware information thus extracted is information on mounting/demounting of a cradle of said portable information processing terminal, and the telephone operation control is an off-hook operation or on-hook operation.

In the same field of endeavor, Jones, Jr. clearly shows and disclose as known in the art a PDA 10 having a removable handset that is positionable in both a substantially flush and a non-flush configuration, which includes a base 12 with a handset 14 removably secured within a cradle 16 recessed within the base (Jones, Jr.: figure 1; col. 3, lines 9-14). Furthermore, Jones, Jr. discloses a tubular shape adapter 38 that is configured to be removably secured to the base 12. The PDA has opposing first and second end portions 40a and 40b. The first end portion 40a is configured to receive the second end portion 26b of the handset 14 and removably secure the handset therein. When the adapter 38 is removably secured to the base 12 and the handset 14 is

Art Unit: 2618

removably secured within the adapter first end portion 40a, the handset is positioned such that a user can easily grasp and remove it from the adapter 38 for use (Jones, Jr.: figure 4; col. 4, lines 30-50).

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Jones, Jr. into the teachings of Vertaschitsch and Tsukamoto et al to provide have a multi-positional PDA handset configuration.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**



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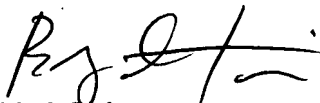
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bobbak Safaipour whose telephone number is (571) 270-1092. The Examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Art Unit: 2618

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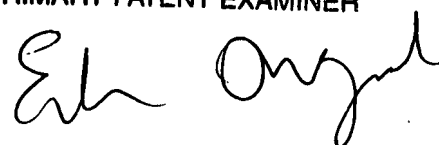


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June 25, 2007

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